

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

JAN 26 1996

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte EDWARD J. GLAMKOWSKI and BARBARA E. KURYS

Appeal No. 94-2022
Application 07/873,862¹

ON BRIEF

Before GOLDSTEIN, TURNER and WEIFFENBACH, Administrative Patent
Judges.

GOLDSTEIN, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the examiner's final rejection of
claims 54 and 56-59. Claims 40-51 have been allowed. A copy of
illustrative claim 54 is appended to this opinion.

The sole reference relied on by the examiner on appeal
is:

Mizia et al. (Mizia)

5,021,590

Jun. 4, 1991

¹ Application for patent filed April 27, 1992. According to
the appellants, the application is a division of Application
07/753,547, filed September 3, 1991; which is a division of
Application 07/431,103, filed November 3, 1989, now U.S. Patent
No. 5,081,117, issued January 14, 1992.

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All of the appealed claims have been finally rejected under 35 U.S.C. § 103 as being unpatentable over Mizia. We shall affirm this rejection.

After the final rejection, appellants attempted to amend claim 54, with which all the claims expressly stand or fall, to remove the recitation "R, is alkyl," but as acknowledged by appellants, this amendment was not entered by the examiner. Appellants' arguments against the examiner's rejection, however, are drafted as though the amendment had been entered. The claims still read on the use of methyl, ethyl, propyl or butylisocyanate as the reactant in the bicyclic amidine catalyzed reaction with a phenolic compound to form a carbamate. This is broadly the subject matter of the Mizia patent.

As appellants have correctly pointed out, appealed claim 54 also reads on the use of higher molecular weight isocyanates, which were not contemplated by Mizia. This fact, however, does not obviate the fact that a substantial portion of the here claimed subject matter would have been obvious from the Mizia disclosure.

Since the above discussed issue is the only one raised by appellants in the brief on appeal, we find on this record no basis for concluding that there was error in the examiner's rejection.

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This decision of the examiner is affirmed.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
1.136(a).

AFFIRMED


MELVIN GOLDSTEIN)
Administrative Patent Judge)


VINCENT D. TURNER)
Administrative Patent Judge)


CAMERON WEIFFENBACH)
Administrative Patent Judge)

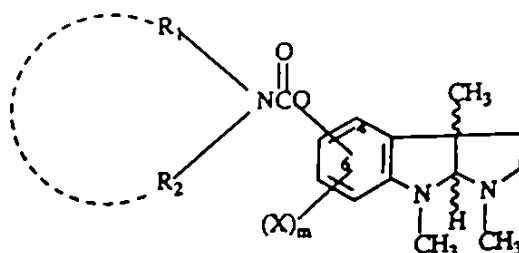
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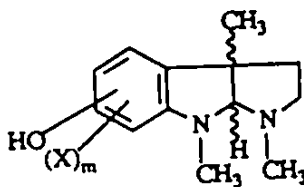
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APPENDIX

54. A method of synthesizing a compound of the formula



where R_1 is [alkyl,] cycloalkyl, bicycloalkyl, aryl or arylloweralkyl; R_2 is hydrogen or alkyl or the group $-NR_1R_2$ taken together forms a monocyclic or bicyclic ring of 5 to 12 carbon atoms; m is 0, 1 or 2; each X is independently hydrogen, halogen, loweralkyl, nitro or amino; or the optical isomers including the 3a-S-cis and 3aR-cis optical isomers or the racemic mixture thereof or a pharmaceutically acceptable acid addition salt thereof which comprises reacting a compound of the formula



where X and m are as previously defined, with an isocyanate of the formula $R_1-N=C=O$, where R_1 is cycloalkyl, aryl or arylloweralkyl, in an inert solvent in the presence of a bicyclic amidine catalyst.